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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MONICA P. FELDER and SEAN P. LOGUE

Appeal 2009-004089
Application 10/605,904
Technology Center 2100

Decided: February 24, 2010

Before JOHN A. JEFFERY, THU A. DANG, and STEPHEN C. SIU,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from a final rejection of claims 1-12, and 14-36. Claim 13 has been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We AFFIRM.

A. INVENTION

According to Appellants, the invention relates to documentation for software, and more particularly to a method and system to manage documentation in software development (Spec. 1, ¶ [0001]).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. A method to manage documentation, comprising:

assigning at least one book of a plurality of books to each of a plurality of writers as an owner of the at least one book by a user on a system to manage documentation, wherein each of the plurality of books includes documentation for a software product;

assigning a predetermined number of line items to each writer by the user on the system to manage documentation to prevent the owner of each book from having to review all of the line items to determine which line items affect the owner's at least one book, wherein each line item corresponds to a change in the software product;

reviewing and investigating each assigned line item; and

performing any changes related to each assigned line item across all affected books by the writer assigned the line item.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Moody	US 5,890,177	Mar. 30, 1999
Plantz	US 6,088,702	Jul. 11, 2000
Ehrman	US 6,610,103 B2	Aug. 26, 2003

Microsoft, *Release Notes for Windows XP Service Pack 1 and Service Pack 1a*,
http://web.archive.org/web/*/http://support.microsoft.com/?kbid=324722 (last reviewed Sep. 9, 2003) (hereinafter “Release Notes for Windows XP”)

Online Training Solutions, “Chapter 8: Collaborating with Others”
Microsoft® Office 2003 Step by Step (2003),
<http://proquest.safaribooksonline.com/0735615233/copyrightpg>
(hereinafter “Online Training Solutions”)

Claims 1-3, 7-12, 14, 15, 18-20, 26, 30, and 31 stand rejected under 35 U.S.C. § 103(a) over the teachings of Moody in view of Plantz and Ehrman.

Claims 4, 5, 16, 17, and 27-29 stand rejected under 35 U.S.C. § 103(a) over the teachings of Moody in view of Plantz, Ehrman, and Release Notes for Windows XP.

Claims 6, 21, 22, 32, and 33 stand rejected under 35 U.S.C. § 103(a) over the teachings of Moody in view of Plantz, Ehrman, and Online Training Solutions.

Claims 23-25 and 34-36 stand rejected under 35 U.S.C. § 103(a) over the teachings of Moody in view of Plantz, Ehrman, Online Training Solutions and Release Notes for Windows XP.

II. ISSUE

Have Appellants shown that the Examiner erred in finding that the combination of Moody in view of Plantz and Ehrman would have suggested the features of claim 1? In particular, the issue turns on whether it would have been obvious to the skilled artisan at the time the invention was made to combine the teachings of Moody, Plantz, and Ehrman.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Moody

1. Moody discloses collaboratively editing a document by multiple editors by providing each editor with a separate copy of the document for each editor to edit his own document copy, wherein the edited copies are then retrieved and compared, and a single mark-up document is created in which sections of each of the edited documents are displayed (Abstract).

Plantz

2. Plantz discloses coordinated publishing, assembly and administration of texts by an unlimited number of authors or editors, each performing editing functions on the same or different portions of a group authored project, wherein the assembled product is displayed to all users (Abstract).

Ehrman

3. Ehrman discloses a system for providing information to a user on modifications made to a base software product which includes information text describing how the program temporary fix modifies the base software product, wherein the cumulative information text may be presented to the user (Abstract).

IV. PRINCIPLES OF LAW

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to

be obvious. *Id.* at 415 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The Court noted that "[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 420. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.* at 421.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 550 U.S. at 418).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

V. ANALYSIS

In this Decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants contend that “there is no teaching or suggestion in Moody, Plantz or Ehrman that their teachings may be combined” (App. Br. 6). In particular, Appellants contend that “Moody teaches comparing edits to the same portions of a copy of a single document by different editors” (*Id.*, emphasis added) while “Plantz teaches a group publishing system, wherein the administrator has the ability to assign different chapters to authors” (*Id.*, emphasis added), and thus Moody “teaches away from assigning different chapters of a book to different editors” (App. Br. 7). Appellants further contend that “Ehrman has no relationship to group publishing or editing by multiple editors to derive a consolidated document” (App. Br. 8).

However, the Examiner finds that 1) “Moody discloses the ability to assign a document (a book), containing a set of predetermined lines, to multiple editors” (Ans. 19); 2) “Plantz discloses the same ability of sending a document to multiple editors; however, also discloses the ability of administrator to assign actual and different portions of the document to the multiple editors for review and editing” (*Id.*); and 3) “Ehrman discloses

another aspect of documentation by disclos[ing] the documentation of the edits and changes to the content to software of what was reviewed and edited” (*Id.*). The Examiner concludes that Moody, Plantz, and Ehrman share a common endeavor of managing documentation (*Id.*).

Thus, the issue we address on appeal is whether the combination of Moody in view of Plantz and Ehrman would have suggested the features of claim 1. In particular, we address whether it would have been obvious to the skilled artisan at the time the invention was made to combine the teachings of Moody, Plantz, and Ehrman.

By contending that Moody, Plantz, and Ehrman do not disclose or are not related to the claimed invention (App. Br. 6-8), Appellants appear to be arguing that individually, Moody, Plantz, and Ehrman do not disclose the features of claim 1. However, the Examiner rejects claim 1 over the combined teachings of Moody, Plantz, and Ehrman, and what the combined teachings would have suggested to one of ordinary skill in the art. One cannot show nonobviousness by attacking references individually where the rejections are based on a combination of references. *See Merck*, 800 F.2d at 1097.

Moody discloses collaboratively editing a document by multiple editors wherein each editor edits his own document copy (FF 1). We agree with the Examiner’s finding that Moody teaches or at the least would have suggested “assigning at least one book of a plurality of books to each of a

plurality of writers as an owner of the at least one book by a user on a system to manage documentation,” as required by claim 1 (Ans. 3).

As the Examiner concludes, and as uncontested by Appellants, “assigning chapters to an author is assigning a predetermined number of line items for an author to edit/review since each chapter consists of a predetermined number of lines” (Ans. 5). Thus, we agree with the Examiner’s finding that Moody also teaches or at least would have suggested “assigning a predetermined number of line items to each writer by the user on the system to manage documentation,” “reviewing and investigating each assigned line item,” and “performing any changes related to each assigned line item across all affected books by the writer assigned the line item” as required by claim 1 (Ans. 3-4).

Plantz discloses coordinated administration of texts by an unlimited number of editors, each performing editing functions on the same or different portions of a group authored project (FF 2). We agree with the Examiner’s conclusion that though Moody “fails to specifically disclose assigning a number line items... to prevent the owner of each from having to review all of the line items to determine which items affect the owner’s at least one book,” it would have been obvious to modify Moody’s invention in view of Plantz (Ans. 4).

That is, since Plantz discloses the well known teaching of assigning editors the same or different portions of a document, we conclude that the

application of one known element (assigning editors different portions of a document) with another (Moody's assigning editors the same portions of a document) would have yielded predictable results to one of ordinary skill in the art at the time of the invention. In particular, we find that replacing the assigning of the same portions of a document to different editors as taught by Moody with Plantz' assigning of different portions of a document to the different editors is no more than a simple arrangement of old elements, with each performing the same function it had been known to perform, yielding no more than one would expect from such an arrangement. *See KSR*, 550 U.S. at 417. Appellants have presented no evidence that using Plantz' assigning of different portions of a document to editors to Moody's collaboratively editing of a document by multiple editors was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Leapfrog*, 485 F.3d at 1162 (citing *KSR*, 550 U.S. at 418-19).

Accordingly, we agree with the Examiner's conclusion that it would have been obvious to combine the teachings of Moody and Plantz since the references share a common endeavor of managing documentation (Ans. 19).

Though Appellants also contend that Moody "teaches away from assigning different chapters of a book to different editors" (App. Br. 7), Plantz discloses that the assignment to the editors could be to the same portions or different portions of the document (FF 2). We agree with the

Examiner's finding that "Moody does not teach away since Moody discloses assigning at least one document to each of the writers" (Ans. 20).

Furthermore, Ehrman discloses a document may be comprised of information describing to a user the modifications made to a base software product (FF 3). We agree with the Examiner's conclusion that though Moody and Plantz "fails[sic] to specifically discloses[sic] each line item corresponds to a change in a software product and each of the plurality of books include documentation for a software product," it would have been obvious to modify Moody and Plantz in view of Ehrman (Ans. 5-6).

That is, since Ehrman discloses that it is well known that a document could include documentation for a software product, we conclude that the application of one known element (Ehrman's documentation for a software product) with another (Moody's and Plantz's document) would have yielded predictable results to one of ordinary skill in the art at the time of the invention. In particular, we find that replacing the Moody's and Plantz's edited documentation with Ehrman's documentation on software products is no more than a simple arrangement of old elements, with each performing the same function it had been known to perform, yielding no more than one would expect from such an arrangement. Again, Appellants have presented no evidence that using Ehrman's documentation on software products as the documentation for collaboratively editing as taught by Moody and Plantz was "uniquely challenging or difficult for one of ordinary skill in the art" or

“represented an unobvious step over the prior art.” *Leapfrog*, 485 F.3d at 1162 (citing *KSR*, 550 U.S. at 418-19)

Accordingly, we agree with the Examiner’s conclusion that it would have been obvious to combine the teachings of Ehrman to those of Moody and Plantz since the references share a common endeavor of managing documentation (Ans. 19).

Thus, Appellants have not persuasively rebutted the Examiner’s conclusion. Accordingly, we find that Appellants have not shown that the Examiner erred in rejecting independent claim 1 and independent claims 14, 21, and 26 falling therewith under 35 U.S.C. § 103(a). Appellants do not provide separate arguments with respect to the rejection of claims 2, 3, 7-12, 15, 18-20, 30, and 31 depending from claims 1, 14 and 26 respectively. Therefore, we find that Appellants have also not shown that the Examiner erred in rejecting dependent claims 2, 3, 7-12, 15, 18-20, 30, and 31 under 35 U.S.C. § 103(a).

Appellants also do not provide separate arguments with respect to the rejection of independent claim 21 and claims 4, 5, 16, 17, 22-25, 27-29, and 33-36 depending from claims 1, 14, 21, 26, and 32, respectively. In particular, Appellants merely state that “Release Notes for Windows XP adds nothing to the teachings of Moody, Plantz and Ehrman” (App. Br. 11), that “Online Training Solutions adds nothing to the teachings of Moody, Plantz and Ehrman” (App. Br. 12) and that “Release Notes for Windows XP

adds nothing to the teachings of Moody, Plantz, Ehrman and Online Training Solutions” (App. Br. 13). Therefore, we conclude that Appellants have also not shown that the Examiner erred in rejecting 1) dependent claims 4, 5, 16, 17, and 27-29 over the teachings of Moody in view of Plantz and Ehrman, and further in view of Release Notes for Windows XP; 2) independent claim 21 and dependent claims 22 and 33 over the teachings of Moody in view of Plantz and Ehrman, and further in view of Online Training Solutions; and 3) dependent claims 23-25 and 34-36 over the teachings of Moody in view of Plantz and Ehrman, and further in view of Online Training Solutions and Release Notes for Windows XP.

As for claim 6 depending from claim 1 and independent claim 32, Appellants merely state that “tracking line items and changes related to line items which correspond to changes in a software product are patentably distinguishable from the track changes features of Microsoft Word” (App. Br. 12 and similarly App. Br. 13). However, the Examiner concludes that the combined teachings would have suggested this claimed feature. We agree with the Examiner.

In particular, Moody and Plantz disclose collaboratively editing the documents (FF 1-2). A skilled artisan would have understood the collaborative editing of the documents to include tracking the line items in the documents and all changes related thereto. Therefore, we conclude that Appellants have also not shown that the Examiner erred in rejecting

dependent claim 6 and independent claim 32 over the teachings of Moody in view of Plantz, Ehrman, and Online Training Solutions.

VI. CONCLUSIONS OF LAW

(1) Appellants have not shown that the Examiner erred in concluding that claims 1-3, 7-12, 14, 15, 18-20, 26, 30, and 31 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Moody in view of Plantz and Ehrman.

(2) Appellants have not shown that the Examiner erred in concluding that claims 4, 5, 16, 17, and 27-29 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Moody in view of Plantz, Ehrman, and Release Notes for Windows XP.

(3) Appellants have not shown that the Examiner erred in concluding that claims 6, 21, 22, 32, and 33 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Moody in view of Plantz, Ehrman, and Online Training Solutions.

(4) Appellants have not shown that the Examiner erred in concluding that claims 23-25 and 34-36 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Moody in view of Plantz, Ehrman, Online Training Solutions and Release Notes for Windows XP.

(5) Claims 1-12 and 14-36 are not patentable.

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VII. DECISION

We affirm the Examiner's rejection of claims 1-12 and 14-36 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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